

REMARKS

I. Status of the Claims

Claims 1-91 are pending in this application. Claims 68-73 have been amended to correct obvious typographical errors. No new matter has been introduced by these amendments, nor do these amendments raise new issues or necessitate the undertaking of any additional search of the art by the Office.

II. Restriction Requirement

Applicants' claims 1-91 are subject to a restriction requirement under 35 U.S.C. § 121. (Office Action dated February 11, 2002, pages 2-3.) The Examiner has grouped the claims as follows:

Group I: compositions of claims 1-54 and 67-69;
Group II: methods of claims 55-57 and 70;
Group III: methods of claims 58-60 and 71;
Group IV: methods of claims 61-63 and 72;
Group V: kits of claims 64-66 and 73;
Group VI: methods of claims 74-76;
Group VII: methods of claims 77-79;
Group VIII: kits of claims 80-82;
Group IX: kits of claims 83-85;
Group X: kits of claims 86-88; and
Group XI: kits of claims 89-91.

Applicants respectfully traverse this requirement. However, to be fully responsive, Applicants elect, with traverse, the subject matter of Group I, claims 1-54 and 67-69, for prosecution on the merits.

For a restriction requirement to be proper, the Examiner must set forth the reasons why the inventions as claimed are either independent or distinct and the reasons for insisting upon restriction. M.P.E.P. § 808 (emphasis in original). In the

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

present case, the Examiner has not shown independence or distinctness between the Groups outlined above.

For example, the *Manual of Patent Examining Procedure (MPEP)* provides a test for determining whether a product and a process of *using* the product are distinct:

A product and a process of *using* the product can be shown to be distinct inventions if either or both of the following can be shown: (A) the process of *using* as claimed can be practiced with another materially different product; or (B) the product as claimed can be *used* in a materially different process.

M.P.E.P. § 806.05(h) (8th ed., August 2001) (emphasis supplied). The Examiner alleges that "the process as claimed could be *used to make* other and materially different product such as one used to dye textiles." (Office Action dated February 11, 2002, page 3, lines 5-6 (emphasis supplied).) The methods of Groups II, III, IV, VI, and VII, however, are methods of *using* a composition, not methods of *making* a product. Therefore, the methods as claimed, contrary to the Examiner's statement, cannot be used to make other materially different products. The Examiner's statement is irrelevant to the issue of whether Group I is independent or distinct from Groups II, III, IV, VI, and VII, thus, the Examiner has not met her burden of showing distinctness. Accordingly, these method claims should be examined together with Group I.

In addition to showing distinctness, a proper restriction requirement requires the Examiner to show that a *prima facie* case of a serious burden exists. M.P.E.P. § 803 (8th ed., August 2001). The Examiner has attempted to show that a serious burden exists by showing that the compositions, the methods, and the kits are classified separately. But "[i]f the search and examination of an entire application can be made

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." M.P.E.P. § 803 (8th ed., August 2001). Applicants respectfully submit that examining the application in total would not present a serious burden to the Examiner. Applicants do not make any statement regarding the obviousness of one group relative to the other, nor should one be inferred. Applicants merely assert that the search of all the pending claims would not be unduly burdensome. Accordingly, the restriction requirement should be withdrawn.

III. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration of the restriction requirement and a timely action on the merits.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 

Michele L. Mayberry
Reg. No. 45,644

Dated: March 7, 2002

Attachment: Appendix (Version with Markings to Show Changes Made)

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

APPENDIX TO AMENDMENT OF MARCH 7, 2002
VERSION WITH MARKINGS TO SHOW CHANGES MADE PURSUANT TO
37 C.F.R. § 1.121(C)(1)(II)

IN THE CLAIMS:

Please replace claims 68-73 with amended claims 68-73, as follows:

68. (Once Amended) A composition according to claim 1, wherein in said R_{10} and R_{11} said alkyl radical of said ~~hydroxyalkyl~~ hydroxyalkyl groups comprises from 1 to 5 carbon atoms.

69. (Once Amended) A composition according to claim 38, wherein in said R_{10} and R_{11} said alkyl radical of said ~~hydroxyalkyl~~ hydroxyalkyl groups comprises from 1 to 5 carbon atoms.

70. (Once Amended) A ~~composition~~ method according to claim 55, wherein in said R_{10} and R_{11} said alkyl radical of said ~~hydroxyalkyl~~ hydroxyalkyl groups comprises from 1 to 5 carbon atoms.

71. (Once Amended) A ~~composition~~ method according to claim 58, wherein in said R_{10} and R_{11} said alkyl radical of said ~~hydroxyalkyl~~ hydroxyalkyl groups comprises from 1 to 5 carbon atoms.

72. (Once Amended) A ~~composition~~ method according to claim 61, wherein in said R₁₀ and R₁₁ said alkyl radical of said ~~hydroxyalkyl~~ hydroxyalkyl groups comprises from 1 to 5 carbon atoms.

73. (Once Amended) A ~~composition~~ kit according to claim 64, wherein in said R₁₀ and R₁₁ said alkyl radical of said ~~hydroxyalkyl~~ hydroxyalkyl groups comprises from 1 to 5 carbon atoms.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com